

REMARKS

Claims 1-5, 7, 8 and 10-11 are pending in this application.

Claim 1 has been amended by deleting the term " R^{43} ," from the second to the last line of claim 1. Accordingly, R^{43} must be $N(R^{44})(R^{45})$ when R^{43} and the central core $N(CO)$ form a ring. In other words, when the central core $N(CO)$ is part of a ring, there must be an $(R^{44})(R^{45})N(CO)N$ - structure.

Claims 7 and 8 have been amended to clarify that the "at least one compound" represented by formula (III) or (IV) is the same "at least one compound" having a hydrogen bond formation rate constant K_f that is 20-4000.

No new matter has been added by way of the above-amendment.

Specification

The Examiner objects under 35 U.S.C. 132 to the Amendment, filed on November 22, 2004, for introducing new matter into the disclosure. In the November 22, 2004 Amendment Applicants added a paragraph claiming priority before the first line of page 1 of the present specification. The Examiner specifically objects to the last line of this paragraph which states, "the entire contents of all applications are hereby incorporated by reference." The Examiner has taken the position that it is improper to incorporate any priority documents by reference after the filing date of the instant application.

In response, Applicants have amended the first paragraph of the specification by deleting the phrase "the entire contents of all applications are hereby incorporated by reference." Accordingly, withdrawal of the objection is respectfully requested.

Issues under 35 USC § 112, Second Paragraph

Claims 7 and 8 are rejected under 35 USC § 112, second paragraph, for being indefinite. Applicants respectfully traverse the rejection.

The Examiner objects to the term “the requirement B” in claims 7 and 8 because requirement B does not have antecedent basis in claim 1. In response, Applicants have amended claims 7 and 8 by replacing the phrase “compound of the requirement B” with the phrase “at least one compound having a hydrogen bond formation rate constant K_f that is 20-4000”. Since the newly added phrase has antecedent basis in claim 1, both claims 7 and 8 are sufficiently definite to satisfy the requirements of 35 USC § 112, second paragraph. As such, withdrawal of the rejection is respectfully requested.

Prior Art Based Issues

The following prior art-based rejections are pending:

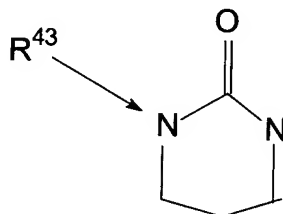
- A) Claims 1-5, 8-11 are rejected under 35 USC §102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Kirk et al. US 5,460,938; and
- B) Claims 1-5 and 8-11 are rejected under 35 USC §102(e) as anticipated by or, in the alternative, under 35 USC §103(a) as obvious over Miura et al. US 6,248,512.

Applicants respectfully traverse the rejections.

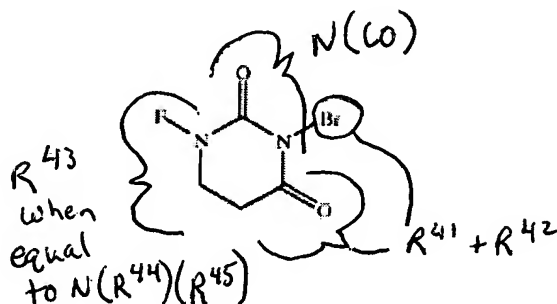
The Examiner has taken the position that both Kirk et al. and Miura et al. teach compounds that are encompassed by inventive formula (IV). With respect to Kirk et al., the Examiner has taken the position that compounds (iv), (vii) and (viii) of column 5 of Kirk et al.

are encompassed by the present claims. Also, the Examiner has taken the position that the compounds in columns 10-14 of Miura et al. are encompassed by inventive formula (IV).

In response, Applicants have amended claim 1 by deleting the term " R^{43} ," from the second to the last line of claim 1. In so doing, R^{43} must be $N(R^{44})(R^{45})$ when both R^{43} and the central core $N(CO)$ are part of the same ring. In other words, when the central core $N(CO)$ is part of a ring, there must be an $(R^{44})(R^{45})N(CO)N$ - structure as shown in the nonlimiting example below.



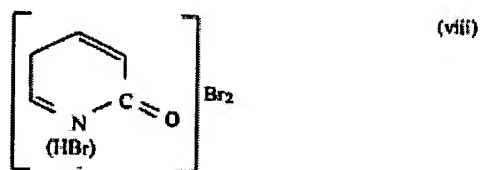
With respect to Miura et al., this amendment excludes compounds in columns 10-14. For example, compound A42, as appearing in column 14, has the following structure:



A42

Here, this compound is not encompassed by newly amended formula (IV), since the nitrogen atom which is surrounded by the two carbonyls is also bonded to a bromine atom. Since neither R⁴¹ nor R⁴² can be a halogen atom, compound A42 is not encompassed by formula (IV) as presently amended.

The compounds of Kirk et al. are even more removed from the inventive compounds, since the compounds of Kirk et al. contain an N(CO) in the ring but this ring nitrogen is not additionally bonded to a carbonyl (CO) as is required from the present claims. See for example the following structure of formula (viii):



According to MPEP 2131 and 2143.03, all claim limitations must be taught or suggested in the cited reference(s) in order for there to be a *prima facie* case of anticipation or obviousness. In view of the fact that there is no overlap in the compounds taught and suggested by Miura et al. and Kirk et al. with the inventive genus of formula (IV), a *prima facie* case of anticipation and obviousness cannot be said to exist. As such, withdrawal of the rejections is respectfully requested.

Double Patenting

Claims 1-5 and 7-11 are rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-6 of U.S. Patent No. 6,696,237 (hereinafter the '237 Patent). Applicants respectfully traverse the rejection.

In paragraph 9 on page 5 of the Office Action, the Examiner states:

In this instant application, the compounds of formula (III) (IV) claimed in the present claimed invention and that phosphoryl compound claimed in the US patent No. 6,696,237 are equivalent with respect to the K_f value.

It appears from these comments, that the Examiner has taken the position that instant claim 1 may include: 1) a compound having a hydrogen bond formation rate constant K_f that is 20-4000; or 2) a compound of formula (III) or (IV). Applicants respectfully submit that this is an improper interpretation of the present claims. The instant claim 1 at least one of the compounds of formula (III) or (IV) and said at least one compound must have the hydrogen bond formation rate constant K_f of 20-4000.

In view of the fact that the photothermographic material of instant claim 1 must have at least one compound of formula (III) or (IV) and claims of the '237 Patent do not recite at least one compound of formula (III) or (IV), the instant claims are not obvious over the claims of the '237 Patent. As such, withdrawal of the rejection is respectfully requested.

Drawings

Applicants respectfully request acknowledgement that the drawings are acceptable.

Priority Documents


Applicants respectfully request that the Examiner acknowledges receipt of the priority documents in the parent application, Serial No. 09/695,864.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Respectfully submitted,

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